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10/026,156	12/18/2001	Steven O. Markel	Inte.24USU1	9484
20311	7590	05/20/2005	EXAMINER	
MUSERLIAN, LUCAS AND MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016			QUELER, ADAM M	
			ART UNIT	PAPER NUMBER
			2179	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/026,156

**Applicant(s)**

MARKEL, STEVEN O.

**Examiner**

Adam M Queler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-8 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8 and 17-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to communications: Amendment filed 03/09/2005.
2. Claims 1-3, 6-8, and 17-23 are pending in the case. Claims 1, 17, and 19 are independent claims.

#### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 1-3, 6-8, 20, 21, and 23 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Applicant has changed the “wizard” of claim 1 to a “system,” however; the term “system” does not carry any implicit meaning of a tangible piece of hardware. Also, none of the elements the claim are necessarily implemented in hardware. Therefore, the claims are at best directed to an arrangement of software and are rejected as not being tangible.

#### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 6-8 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 6-8 provides for the use of game shows, voting and creating a form, but, since the claim does not set forth any steps involved in the method/process, it is unclear what

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method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 6-8 recite a system. These claims appear at first glance to define a product for performing a process. However, there is no specific structure recited in these claims. The elements of the "apparatus" are defined entirely by functional language, which can be implemented by either hardware or software code. Therefore, they will be analyzed as a series of steps to be performed on a computer. This is acceptable treatment of the claims under the Examination Guidelines, which were written in light of several opinions by the courts:

"If the functionally-defined disclosed means and their equivalents are so broad that they encompass any and every means for performing the recited functions, the apparatus claim is an attempt to exalt form over substance since the claim is really to the method or series of functions itself. In computer-related inventions, the recited means often perform the function of 'number crunching' (solving mathematical algorithms and making calculations). In such cases the burden must be placed on the applicant to demonstrate that the claims are truly drawn to specific apparatus distinct from other apparatus capable of performing the identical functions. If this burden has not been discharged, the apparatus will be treated as if it were drawn to the method or process which encompasses all of the claimed 'means.'"

See *In re Walter* 205 USPQ 397, 408 (CCPA 1980), *In re Abele* 214 USPQ 682, 688 (CCPA 1982), and *Ex parte Akamatsu*, 22 USPQ2d 1915, 1920. The disclosed means of applicant's specification is defined solely in terms of the functions to be performed. Beyond this applicants fail to disclose any specific apparatus or means for carrying out the disclosed functions. Applicants have failed to discharge their burden of demonstrating that the claims are drawn to any specific apparatus distinct from other apparatus capable of performing the same function. Therefore, system claims 6-8 are analyzed as a series of steps. Therefore, Applicant's amendment to recite a "system" is insufficient to overcome the rejection.

Claims 6-8 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a

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process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1 and 22 remain rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al (US 20030196164A1, filed 9/15/1999).**

**Regarding independent claim(s) 1 and 22**, Gupta discloses a user interface and input box for identifying content (Fig. 8, 262). Gupta discloses a prompt and input box for entering a start time that content will be displayed (Fig. 8, 268). Gupta discloses a monitor with a data signal and a video signal (Fig. 3), which are thereby deemed integrated.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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**10. Claims 2-3, and 6-8 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta, and further in view of Bayeh et al (US006012098A, filed 2/23/1998).**

**Regarding dependent claim(s) 2,** Gupta teaches that the content is stored in a database (para. 47). Gupta does not disclose storing the content as XML. Bayeh teaches translating stored content into XML (col. 8, ll. 3-18). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayeh and Gupta, therefore translating the content, in order to provide a standardized output (Bayeh, col. 8, ll. 19-22).

**Regarding dependent claim(s) 3,** Gupta does not teach generating an HTML file. Bayeh teaches an XSL parser to generate an HTML file (col. 9, ll. 5-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to format the information as HTML because browsers expected to receive HTML (col. 2, ll. 52-53).

**Regarding dependent claim(s) 6-8,** because the claims merely recite an intended use, the categories of creations are deemed to be non-functional descriptive data, and are rejected similarly as claim 1 above.

**11. Claims 17-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta, and further in view of Bayeh, and further in view of Logan (US 20030093790A1, priority date 3/28/2000).**

**Regarding independent claim(s) 17,** Gupta discloses a user interface (Fig. 8, 262). Gupta discloses a prompt and input box for entering a start time and end time capable of selecting a particular frame (Gupta, para. 61). Gupta teaches that the content is stored in a database (para. 47). Gupta discloses a monitor with a data signal and a video signal (Fig. 3), which are thereby deemed integrated. Gupta does not disclose storing the content as XML. Bayeh teaches

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translating stored content into XML (col. 8, ll. 3-18). Bayeh teaches a first XSL parser to generate a first HTML file (col. 9, ll. 5-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayeh and Gupta, therefore translating the content, in order to provide a standardized output (Bayeh, col. 8, ll. 19-22). Gupta and Bayeh do not explicitly disclose a television program, but a general multimedia presentation (Gupta, para. 4). Logan discloses integrating the content into the television program (para. 80). It would have been obvious to one of ordinary skill in the art at the time of the invention to extend the general multimedia presentations of Gupta and Bayeh into the television program of Logan, thereby integrating the HTML code into the television program, in order to display more information about television program (Logan, para. 6).

**Regarding dependent claim(s) 18**, Gupta does not teach generating an HTML file. Bayeh teaches a second XSL processor for different presentation requirements, (col. 8, ll. 55-57), which would encompass a different device. It would have been obvious to one of ordinary skill in the art at the time of the invention to format the information as HTML because browsers expected to receive HTML (Bayeh, col. 2, ll. 52-53).

**Regarding independent claim(s) 19**, Gupta entering content information (Fig. 8, 262). Gupta teaches that the content is stored in a database (para. 47). Gupta discloses a monitor with a data signal and a video signal (Fig. 3), which are thereby deemed integrated. Gupta does not disclose storing the content as XML. Bayeh teaches translating stored content into XML (col. 8, ll. 3-18). Bayeh teaches a first XSL parser to generate a first HTML file (col. 9, ll. 5-8). Bayeh teaches a second XSL processor for different presentation requirements, (col. 8, ll. 55-57), which would encompass a different device. It would have been obvious to one of ordinary skill in the art at

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the time of the invention to combine Bayeh and Gupta, therefore translating the content, in order to provide a standardized output (Bayeh, col. 8, ll. 19-22). Gupta and Bayeh do not explicitly disclose a television program, but a general multimedia presentation (Gupta, para. 4). Logan discloses integrating the content into the television program (para. 80). It would have been obvious to one of ordinary skill in the art at the time of the invention to extend the general multimedia presentations of Gupta and Bayeh into the television program of Logan, thereby integrating the HTML code into the television program, in order to display more information about television program (Logan, para. 6).

**12. Claims 20, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta as applied to claim 1 above, and further in view of Applicant's Admitted Prior Art.**

**Regarding dependent claim(s) 20,** Gupta does not explicitly disclose the webTV format.

Applicant admits that the WebTV format was one that must be considered, and was therefore was a desired format at the time of the invention (p. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the WebTV format for that desired reason.

**Regarding dependent claim(s) 20,** Gupta does not explicitly disclose the AOLTV format.

Applicant admits that the AOLTV format was one that must be considered, and was therefore was a desired format at the time of the invention (p. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the AOLTV format for that desired reason.



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**Regarding dependent claim(s) 23**, Gupta does not explicitly disclose displaying a signal on two monitors. Official Notice is taken that it was well-known and common at the time of the invention to display a signal on two monitors. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to display the signal on a plurality of monitors to display the signal to two different people.

***Response to Arguments***

13. Applicant's arguments filed 3/9/2005 have been fully considered but they are not persuasive.

**Regarding Applicant's remarks on §101 rejections of claim 1:**

Applicant has changed the "wizard" of claim 1 to a "system," however; the term "system" does not carry any implicit meaning of a tangible piece of hardware. Also, none of the elements the claim are necessarily implemented in hardware. Therefore, the claims are at best directed to an arrangement of software and are rejected as not being tangible.

**Regarding Applicant's remarks on §112 rejections of claims 6-8:**

See rejection under §112 of claims 6-8 above.

**Regarding Applicant's remarks on Claim 1:**

Applicant alleges Gupta does not teach integrated signals. Gupta discloses a monitor with a data signal and a video signal (Fig. 3), which are thereby deemed integrated.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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